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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,051	04/10/2004	Ronald John Rosenberger		2238

7590 11/14/2005
Ronald Rosenberger
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EXAMINER

KAVANAUGH, JOHN T

ART UNIT PAPER NUMBER

3728

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/822,051	Applicant(s) ROSENBERGER, RONALD JOHN	
	Examiner Ted Kavanaugh	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10-28-2004</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "shoe sole", "novelty scented material/formulation compound", "a void", "a receptacle", "a hole", "an 'O' ring", "multi-sectional construction", "novelty visual aspect" and "two or more novelty plus or inserts" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The “void can accommodate said at least one novelty scented plug or insert comprising any embodiment of an ‘O’ ring around the non-wearing circumference of the entire shoe sole” is not clear. The description of the “ring” in the specification was not understood and therefore it is not possible to make and/or use the invention.
4. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of the terms “novelty” and “unique” and “etc.”, used throughout the claims, is not known and therefore it is not clear of the metes and bounds of such expressions. How is the scent or fragrance novel and unique? What further elements would be included with the expression “etc.”?

Claim 8 doesn’t appear to further limit the claimed “shoe sole” and the scope of the phrase “void creating means” is not clear.

Claim 6 is unclear inasmuch as the plug, which contains the scented material/compound, is only functionally recited. The scented material was positively recited in claim 1 but now in claim 6 the plug is only functionally recited and therefore the scope of the claim is not clear.

In claim 7, the phrase "does not comprise said at least one novelty scented...smoking means" is not understood. Is application trying to claim the sole, the void, the receptacle or the plug doesn't have these features?

Claim 18 is not clear. The plug or insert having a multi-sectional construction is not understood.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by US 4257176 (Hartung et al).

Hartung teaches a shoe sole (insole) comprising a novelty scented compound wherein the compound gives off a unique aroma when said sole is in normal use due to friction, heat buildup and wear (see col. 1, line 48 to col. 2, line 5).

7. Claims 1,6-7,9,11,14,15,17,18,19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5732485 (Laughlin et al).

Laughlin teaches a shoe sole comprising a novelty scented compound wherein the compound gives off a unique aroma when said sole is in normal use due to friction, heat buildup and wear (see col. 2, lines 31-36), wherein said shoe sole comprises a void having a receptacle (see figures 1,2 and 4) for insertion of a plug (14). Regarding claim 9, the "O" ring is shown retainer 2, see figure 2. Regarding claim 11, the sole of Laughlin has at least one color. Regarding claims 19-21, these claims consist of functional language and the sole of Laughlin is inherently capable of performing all of the functional language as claimed. Regarding claim 15, the plug as shown in figure 2 provide a novel visual aspect.

Claim Rejections - 35 USC § 103

8. Claims 8 and 12,13 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 5732485 (Laughlin et al).

Laughlin teaches a shoe sole as claimed (see the rejection above) but is silent with regard to the means of creating the void. This limitation is being treated as a product by process limitation. Thus, it would appear obvious to make the void by a number of different conventional known means.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin '485.

Laughlin teaches the shoe sole as claimed except for the plugs being in a side by side arrangement. Although, Laughlin teaches the plug in different locations, see figure 3 and 4. It would appear to be an obvious design choice to provide two plugs (scented material) in a side by side relationship, inasmuch as the plugs can be located in a

number of different locations and obviously the more plugs provided the better deodorizer for masking foot odor.

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin '485 in view of US 5024008 (Maples).

Laughlin teaches a shoe sole as claimed except for the scent means compound having one pheromone. Maples teach the sole scented dispenser having an animal lure scent (i.e. pheromone); see col. 3, lines 15-20. It would have been obvious to provide the scent compound with one of a pheromone, as taught by Maples, for a hunter to lure an animal.

11. Claim 3 and 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin '485 in view of US 5261169 (Williford).

Laughlin teaches a shoe sole as claimed except for the scent means compound comprising smoking means. The smoking means is the result of powder being used. Williford teaches a sole having a scented means comprising powder (36). It would have been obvious to one of ordinary skill in the art for the scented compound to be a powder, as taught by Williford, to provide a scented composition and an antimicrobial composition.

12. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin '485 in view of US 5039243 (O'Brien).

Laughlin teaches a shoe sole as claimed except for the shoe comprising materials that are colored in accordance to the scent of the shoe sole. O'Brien teaches

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the colors and the scents corresponding to each other, see the abstract. It would have been obvious to one of ordinary skill in the art to shoe sole of Laughlin with a color and scent that correspond with each other, as taught by O'Brien, to provide a pleasing appearance.

Conclusion

13. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:

--“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”

-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.


For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300

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(FORMAL FAXES ONLY). Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM.


Ted Kavanaugh
Primary Examiner
Art Unit 3728

TK
November 9, 2005